

In re the Application of
Hartley Moyes

Serial No. 09/985,673

Filed: November 5, 2001

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Art Unit: 3635
Examiner: Chi Q. Nguyen
Attv. Dkt: 6240,241

Title: METHOD OF MANUFACTURING:
A MOLDED DOOR SKIN FROM A FLAT
WOOD COMPOSITE, DOOR SKIN :
PRODUCED THEREFROM, AND DOOR
MANUFACTURED THEREWITH :

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
Madison East, Concourse Level Room C 55
600 Dulany Street
Alexandria, VA 22314

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Dear Sir:

In response to the Examiner's Answer mailed July 24, 2008, Appellant respectfully requests that the Board of Patent Appeals and Interferences consider the following additional arguments in response to the Examiner's Answer and reverse the decision of the Examiner in whole. The Commissioner is hereby authorized to charge Applicant's Deposit Account No. 50-0548 for any fees necessary to maintain the pendency of this appeal.

REMARKS

As an initial matter, Appellant reasserts its position that all claims on appeal are separately patentable. In the Examiner's Answer, claims have been grouped together by the examiner for presenting arguments. Appellant submits that claims 18-20 and 23-39 do not stand or fall together. Arguments for patentability of each claim are presented separately in Appellant's Appeal Brief, but grouped herein in light of the Examiner's presentation of arguments.

The rejection of claims 18-20, 25-29, 32-36 and 39 as being obvious over Lynch should be reversed

Regarding claims 18 and 33: The Examiner acknowledges that Lynch fails to disclose a door skin having a bond strength of at least about 2.0 N/mm², but argues that the claimed bond strength is an obvious design choice and that Appellant fails to show the criticality for the claimed bond strength.¹ In response to Appellant's arguments, the Examiner states that "appellant's disclosure fails to show the criticality for specifically claimed bonded [sic] strength" and that "having a specific range of bonding [sic] strength to meet desirable application would have been considered 'obvious to try'". See Examiner's Answer, pgs. 6-7. The Examiner provides no basis for such assertions.

The bond strength limitation cannot be dismissed as merely being a matter of "obvious design choice" based solely on the examiner's assertion that such is the case.

¹ As noted in Appellant's Appeal Brief, it was unclear if the Examiner abandoned the criticality and design choice arguments in favor of the argument that bond strength is not a structural limitation. It now appears from the Examiner's Answer that the structural limitations argument has been abandoned. Other than stating generally in response to Appellant's arguments, "only structural limitations are considered for patentable weight", this assertion is not addressed in the Examiner's Answer.

The examiner points to no evidence that the art recognized a need for increased bond strength or that a “reformed” wood composite door skin would be an avenue for increasing bond strength. The increased bond strength was an unexpected result arising from manufacture of a “reformed” material. Indeed, as noted in the specification at page 14, lns. 6-10, prior techniques retained uncured resin in the door skin conventionally manufactured from a mat in order to eliminate brittleness. Appellant has therefore proceeded contrary to conventional wisdom by increasing hardness. Nothing in the art cites a need for increased hardness or a mechanism for achieving it. A design choice is not obvious if the claimed structure and the function it performs are different from the prior art. See *In re Gal*, 980 F.2d 717, 25 U.S.P.Q.2D (BNA) 1076 (Fed. Cir. 1992). The claimed bond strength is neither disclosed nor suggested by the prior art.

Moreover, the Examiner’s assertions are contrary to Appellant’s disclosure and arguments presented. Specific disclosure and arguments, cited in Appellant’s Appeal Brief, demonstrate the unexpected results and advantages of the claimed invention, and specifically the claimed bond strength, compared to the prior art. This information has been neither properly considered nor commented upon by the Examiner. Indeed, when challenged as to the basis of the criticality and obvious design choice arguments during the interview on March 8, 2007, the Examiner acknowledged that the claimed bond strength was not an obvious design choice. See Interview Summary of May 11, 2007. The recitation of a defined bond strength is a “structural limitation” much like reciting “wood composite”, “door frame”, etc. Patents are legion in various arts where strength or like limitations distinguish over the art. The examiner provides no citation to authority as to why this limitation, not shown in the art, may be ignored.

At Page 3 of the Examiner's Answer the examiner contends that the bond strength is "to prevent the skins from separating from the frame." This statement suggests that the examiner has not properly understood the claims. The bond strength being claimed is the internal bond strength of the door skins, not the strength of the bond securing the door skins to the frame. It thus appears that the examiner is considering a bond strength other than what is being claimed.

The Examiner argues in this appeal that it would have been obvious to one skilled in the art to increase bond strength "by providing a stronger bonding material to achieve a desirable result". See Examiner's Answer, p. 6. The Examiner has not demonstrated what, if any, theoretical bonding material would have achieved the claimed bond strength and worked for its intended purpose in a door skin. Recall that the product is a "reformed" door skin, and not one being initially manufactured from a bat or mat of wood fibers. No evidence has been proffered which verifies that bond strength can be increased to the claimed levels simply by substituting a different bonding agent into a conventional process. As earlier noted with reference to the specification, the art teaches that some portion of the resin conventionally is left uncured to avoid brittleness. The examiner does not take this into account. Essentially, the Examiner points to a desired result, but not to any means in the prior art for attaining the result. Indeed, the process for forming a door skin having the claimed bond strength is itself unexpected and patented. U.S. Patent No. 6,312,540, the parent of the present application, includes claims directed to the disclosed method that were pursued following a restriction requirement.

Regarding Claim 19 and 36: The Examiner argues that Appellant's disclosure "expressly stated that 'preferably a bond strength of at least about 2.5 N/mm²' would made [sic] a better bonding strength than the prior art." See Examiner's Answer, p. 6. It is unclear what argument is being raised.

To the extent the Examiner is relying on Appellants' own disclosure and seeking to shift the burden to the Appellants to show criticality of the bond strength, such an argument is not proper as noted in Appellant's Appeal Brief. To the extent the Examiner is asserting that Appellant is limited to claiming only one preferred embodiment, such an argument is also without merit. A claim may cover more than one embodiment.

The Examiner offers no specific response to Appellant's counter-arguments with respect to this assertion.

Regarding Claims 20, 25, 34 and 35: The Examiner acknowledges that Lynch fails to disclose a molded door skin having a density of between about 550 kg/m³ and about 1200 kg/m³, or a molded door skin having a substantially constant density. In rejecting these claims, the Examiner again relies upon the criticality and/or design choice arguments.

The substantially constant density of the resulting skin is a result of the unique and patented reforming process disclosed by Appellant. The Examiner's assertions fail to properly take into account the explicit specification disclosure.

Regarding Claims 26, 27, 28 and 29: The Examiner asserts that "Lynch discloses the basic structural elements for the claimed invention" for each of claims 26-29, but provides no specific argument with respect thereto. The Examiner fails to comment on any arguments raised by Appellant. Nor does the Examiner disagree that Lynch fails to

disclose a door skin having a contoured portion with a thickness differing from the thickness of inner and outer planar areas, as required by claim 29. Contrary to the Examiner's conclusory statements, Lynch is silent as to any thickness variations of the door skin.

Regarding Claims 32 and 39: The Examiner acknowledges that Lynch does not disclose a foam filler disposed within the hollow core area of the claimed door. The Examiner does not rely upon any other reference other than Lynch in support of these rejections. As such, it is assumed that the Examiner is again raising the design choice argument. However, no specific analysis or reasoning is presented in support thereof.

These rejections are unsubstantiated and should be reversed.

The rejection of claims 23, 24, 30, 31, 37 and 38 as being obvious over Lynch in view of Aufderhaar should be reversed.

Regarding Claims 23, 24, 30, 31, 37 and 38: As acknowledged by the Examiner, Lynch fails to teach a door skin having a moisture imperious barrier or a sealer as required by these claims. Instead, the Examiner relies upon Aufderhaar.

As discussed in Appellant's Appeal Brief, the excerpt from Aufderhaar upon which the Examiner relies does not relate to a barrier that is disposed on an exterior surface of a reformed molded wood composite door skin, as required by claims 23, 24, 37 or 38. Furthermore, Aufderhaar fails to teach the use of a pigmented sealer, as required by claim 30. Moreover, the disclosure of Aufderhaar specifically suggests that the surface of the resulting panel does not have a uniform colored surface, contrary to the

requirements of claim 31. The Examiner fails to address these inconsistencies raised by Appellant.

CONCLUSION

For the reasons set forth herein, as well as those presented in Appellant's Appeal Brief, it is respectfully requested that the Board reverse the Examiner's Final Rejection. Allowance of all pending claims is solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W. C. Schrot', with a stylized flourish at the end.

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